

REMARKS

This application has been reviewed in light of the Office Action dated December 3, 2003. Claims 29-46 are presented for examination, of which Claims 29, 34, 39, and 46 are in independent form. Claims 29, 31, 34, 36, 39, 41, and 46 have been amended to define Applicant's invention more clearly. Favorable reconsideration is requested.

The Office Action rejected Claims 29-46 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,765,170 (Morikawa) in view of U.S. Patent No. 5,619,648 (Canale et al.). Applicant submits that independent Claims 29, 34, 39, and 46, together with the claims dependent thereon, are patentably distinct from the cited prior art for at least the following reasons.

The aspect of the present invention set forth in Claim 29 is directed to a communication device that includes reception means, acquisition means, a memory, judgment means, and warning means. The reception means sends a transmit request to an e-mail server and receives an e-mail transmitted from the e-mail server in response to the transmit request. The acquisition means acquires size information of an e-mail, stored in the e-mail server, from the e-mail server before sending the transmit request to the e-mail server. The memory stores e-mails received by the reception means.

The judgment means judges whether it is possible or not to receive at the communication device an e-mail stored in the e-mail server, according to the size information and a storable capacity of the memory. As a result of a judgment by the judgment means that an e-mail to the communication device cannot be received, the warning means visually outputs warning information indicating that the e-mail stored in the e-mail server cannot be received.

Morikawa relates to an electronic mail processing system. Apparently, Morikawa teaches the use of folders for storing received electronic mail, and also teaches the use of a management device for classifying a data file written in the received electronic mail and selecting a folder for storing the data file.

Canale et al. relates to an e-mail filter system for filtering junk e-mail. Apparently, Canale et al. teaches that the system filters e-mail using non-address information and a user's model information (e.g., keywords) to determine whether an e-mail message is to be provided to the user.

Applicant submits that a combination of Morikawa and Canale et al., assuming such combination would even be permissible, would fail to teach or suggest a communication device that includes "judgment means for judging whether it is possible or not to receive at said communication device an e-mail stored in the e-mail server, according to the size information and a storable capacity of said memory," and "warning means for visually outputting warning information indicating that an e-mail to said communication device, stored in the e-mail server, cannot be received, as a result of a judgment by said judgment means," as recited in Claim 29.

In the Office Action, it is conceded that Morikawa does not disclose the output means of Claim 29, and it is alleged that Canale et al. remedies this deficiency of Morikawa. That is, it is asserted in the Office Action that the output means of Claim 29 is disclosed in Canale et al., because Canale et al. teaches "using email filter to reduce junk email and informing users 105(*n) via interactive user interface that the mail has arrived, see figs. 1 and 3, abstract, col.3 line 12 to col.4 line 34 and col.7 line 28 to col.8 line 56." (Note that the output means corresponds to the warning means of amended Claim 29.)

Applicant respectfully submits that a careful reading of Canale et al. reveals that the mail filter 109 filters mail based on a predetermined filtering model 113. If mail successfully passes through the mail filter 109, a user 105 is informed that mail has arrived. (See column 3, lines 44-48, which recites: "If recipient description 125 specifies a recipient which is of the same kind as that specified by user model 113, mail filter 109 adds mail item 119 to filtered mail 115 and informs user 105(n) via interactive user mail interface 117 that mail has arrived.") In other words, Canale et al. generates a "mail is here" type message upon the successful passage of an incoming message through the mail filter 109.

In contrast to the teachings of Canale et al., a feature of Claim 29 is that a *warning* is issued after a judgment is made that e-mail *cannot* be received. The warning is issued before the e-mail is sent from the server in which it is stored. Thus, Applicant submits that merely adding the Canale et al. "mail is here" type message feature to the Morikawa system would not result in or even suggest the warning feature of Claim 29. More specifically, because Canale et al. only teaches alerting a user to the *arrival* of mail, using that feature in the Morikawa system would merely produce a modified Morikawa system having the added feature of alerting users upon successful passage of a mail through a filter, but would not include the feature of warning users when e-mail *cannot be received*.

That is, Applicant respectfully submits that the "mail is here" type message of Canale et al. is not equivalent to or suggestive of a warning that e-mail *cannot* be received. Accordingly, Applicant submits that Claim 29 is patentable over the cited art, and respectfully requests withdrawal of the rejection under 35 U.S.C. § 103(a). Independent Claims 34, 39, and 46 include a warning feature similar to that discussed above. Therefore, those claims also are

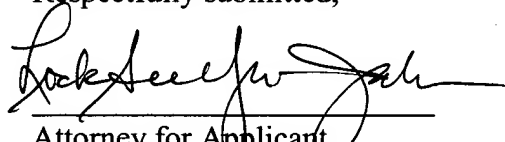
believed to be patentable for at least the same reasons as discussed above.

The other rejected claims in this application depend from one or another of the independent claims discussed above and, therefore, are submitted to be patentable for at least the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, individual reconsideration of the patentability of each claim on its own merits is respectfully requested.

In view of the foregoing amendments and remarks, Applicant respectfully requests favorable reconsideration and early passage to issue of the present application.

Applicant's undersigned attorney may be reached in our New York Office by telephone at (212) 218-2100. All correspondence should continue to be directed to our address listed below.

Respectfully submitted,



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